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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/412,897	10/05/1999	SVERRE SLOTTE	297-008927-U	1254

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CLARENCE A GREEN
PERMAN & GREEN
425 POST ROAD
FAIRFIELD, CT 06430

EXAMINER

TRAN, THIEN D

ART UNIT

PAPER NUMBER

2665

DATE MAILED: 09/24/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/412,897

Applicant(s)

SLOTTE ET AL.

Examiner

Thien D Tran

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being Chung et al by US 6,359,871).

Regarding claim 1, Chung discloses a method for complementing a telephone connection with additional information, comprising the steps of

initiating the telephone connection between a transmitting telecommunication device and a receiving telecommunication device (col.20 lines 15-30),

composing, at said transmitting telecommunication device (portable device), a signaling message of predetermined form to be transmitted in association with the telephone connection, said signaling message containing the additional information, indicating, within said signaling message, the intended receiving part within said receiving telecommunication device of at least part of said signaling message, and transmitting said signaling message from said transmitting telecommunication device to said receiving telecommunication device. See col.8 lines 35-50, col.9 lines 25-45.

Regarding claim 2, Chung discloses the step of indicating, within said signaling message, a CAI protocol (certain protocol) used in the creation of said signaling message. See col.7 lines 45-55.

Regarding claim 3, Chung discloses the step of indicating, within said signaling message, a certain coding scheme used in the creation of said signaling message. Col.9 lines 10-30.

Regarding claim 4, Chung discloses the steps of composing said signaling message from a number of header fields and a data field, and indicating, within said signaling message, the combined length of said header fields. Col.11 lines 15-25, figure 3.

Regarding claim 5, Chung discloses a telecommunication device for the transmission of signaling and payload information, comprising a transceiver unit,

Art Unit: 2665

a unit for processing received payload information,
a unit for processing payload information to be transmitted,
a control block, and
a signaling unit of which said transceiver unit is arranged to direct received signaling information to the control block and to take signaling information to be transmitted from the control block, and said signaling unit is arranged to compose a signaling message of predetermined form to be transmitted in association with a payload information transmission connection, and to indicate, within said signaling message, the intended receiving part within another telecommunication device of at least part of said signaling message. See col.13 lines 5-30, col.8 lines 35-50, col.9 lines 25-45.

Regarding claim 6, Chung discloses that signaling unit is additionally arranged to receive a signaling message from another telecommunication device in association with a payload information transmission connection, and to direct at least part of the received signaling message to a certain functional block within the telecommunication device according to an indication contained in the received signaling message. See figure 3.

Response to Arguments

3. Applicant's arguments filed 07/03/2003 have been fully considered but they are not persuasive.

Applicant argues that Chung does not disclose a telephone connection. However, Examiner disagrees with the argument because Chung discloses a voice (phone) connection to talk through base stations. See col.14 line 51.

Applicant argues that Chung does not disclose initiating the telephone connection, at the transmitting telecommunication device, a signaling message of predetermined form to be transmitted in association with the telephone connection. However, Examiner respectfully disagrees with the argument because Chung discloses a portable (transmitting device) initiates a telephone connection with another portable (receiving device) through base stations, col.20 lines 10-25, and that the call set-up message (signaling message or control message) comprising addresses of calling and called portable. Format of the messages shown in figures 3 and 4 is considered as a predetermined form. See col.20 lines 18-20.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2665

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Thien Tran whose telephone number is (703) 308-4388. The examiner can normally be reached on Monday-Friday from 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (703) 308-6602. Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Thien Tran



**ALPUS H. HSU
PRIMARY EXAMINER**